REMARKS/ARGUMENTS

Claims 15-57 are all the claims currently pending in the application. Based on the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

I.   **Rejection of Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 under 35 U.S.C. § 103(a)**

Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 97/19429 to Deluca et al. (hereinafter referred to as "Deluca") in view of U.S. Patent No. 6,044,248 to Mochizuki (hereinafter referred to as "Mochizuki") further in view of U.S. Patent No. 6,421,707 to Miller (hereinafter referred to as "Miller").

Claim 15 requires "[a] method … comprising: generating *a compound message including a text part* and at least one *graphical icon part*, the compound message generation including reading a user inputted text part and converting the inputted text part into a predefined message text format, adding *a graphical part* to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format, and adding position information in the message defining a position of the at least *one graphical icon part in the text part*; and *transmitting of the message* via the wireless network."

Applicant again respectfully submits that the combination of Deluca, Mochizuki and Miller does not teach or suggest at least the above features of claim 15. In contrast to claim 15, there simply is no mention, teaching or suggestion in either Deluca, Mochizuki or Miller (either alone or in combination) relating to any compound message which includes a text part and a graphical icon part that is transmitted via a wireless network, as required by claim 15 and as pointed out in the Amendments filed July 5, 2006 and March 21, 2007. In rejecting claim 15, the Examiner continues to cite to page 5, lines 13-14 of Deluca for the proposition that Deluca, either alone or in combination with Mochizuki and Miller, teaches generating a compound message including a text part and at least one graphical icon part. (See pg. 2 of the Office Action) Applicant again respectfully disagrees.

As mentioned in the Amendments filed July 5, 2006 and March 21, 2007, Deluca, in contrast to claim 15, at best, discloses a system in which messages are composed and transmitted to a receiving device 100 in which a <u>numerical code</u> is utilized to identify an icon (prestored by the

receiving device), with the code being selected by the composer of the message at a transmitting

device (See, e.g., terminal 305 of FIG. 11 of Deluca). Upon receipt, the receiving device uses the

numerical code to identify and retrieve the graphical icon from a memory of the receiving device,

thereby eliminating a need to transmit any information to the receiving device beyond the numerical

code to cause the display of the encoded icon in association with a text message. In this regard, it

was pointed out in the Amendment filed July 5, 2006 and March 21, 2007 that Deluca (either alone

or in combination with Mochizuki and Miller) does not teach or suggest that any transmitted

message which contains a graphical part, but rather, at best, discloses that a transmitted message that

contains only text, including the numerical code, e.g., "#07" which the Examiner appears to concede

is text. (See pg. 2 of the Office Action)[1]

As pointed out in the Amendments filed July 5, 2006 and March 21, 2007, the cited portion

(i.e., page 5, lines 13-14) of Deluca, at best, describes a message containing only text, "for example,

alphanumeric characters." (emphasis added) To be precise, page 5, lines 13-14 of Deluca discusses

that the "[r]eception of a display command for a message comprising the characters of "#07TOM?"

or "TOM?#07" results in the subsequent presentation of the image associated with the code "#07" at

the display 130. (emphasis added) This is because the receiver 100 recognizes the alphanumeric

code "#07" in the message and retrieves corresponding image data, i.e., coffee mug (based on the

code), which is previously stored in a graphics database 155 of the receiver 100. (See pg. 2, lines 6-8

and FIG. 2 of Deluca).

In view of the foregoing, Applicant again submits that Deluca, (either alone or in

combination with Mochizuki and Miller) at best, discloses that any graphical part corresponding to

the transmitted numerical code is retrieved from a memory (i.e., graphics database) and displayed

after the message is received at the receiving device 100. (See page 6, line 31 – page 7, line 3 of

Deluca) As pointed out in the Amendments filed July 5, 2006 and March 21, 2007, Deluca (either

alone or in combination with Mochizuki and Miller) at best discloses only messages that include

either (1) a numerical code, e.g., "#07" (See pg. 5, lines 3-12); (2) a numerical code and any desired

additional text to be displayed at the receiving device, e.g., "TOM?#07" (See pg. 5, lines 13-26); or

(3) a numerical code and any desired additional numerals to be displayed at the receiving device, e.g.,

"#073331111" (See pg. 5, line 27 – page 6, line 9). Deluca discloses that the numerical code uses,

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[1] Where the Examiner considers "text #07 to be an icon."

for example, "predetermined characters commonly found on conventional telephone receivers." (See page 3, lines 30-31 of Deluca) (emphasis added) Such characters would typically include the numerals "0-9" and the symbols "#" and "*." As noted in the Amendments filed July 5, 2006 and March 21, 2007, a person skilled in the art to which Deluca and the present application pertain would clearly understand that "text" generally includes letters, numerals, and symbols (e.g., "#" and "*"). As such, a person skilled in the art would consider the messages disclosed by Deluca to include only text. As noted above and previously pointed out in the Amendments filed July 6, 2006 and March 21, 2007, the Examiner states in the Office Action that "#07" (an example numerical code from Deluca) is text. (See pg. 2 of the Office Action) In view of the foregoing, the messages taught by Deluca include only text and do not include a graphical icon part. As such, the recitation in claim 15 that the *message transmitted* via the wireless network contains both *a text part and a graphical icon part* is not taught or suggested by Deluca (either alone or in combination with Mochizuki and Miller).

 As such, it was pointed out that Deluca (either alone or in combination with Mochizuki and Miller) does not teach or suggest generating a compound message including a text part and at least one graphical icon part ... and *transmitting* of *the message* via the wireless network," as required by claim 15. The Examiner has not responded to Applicant's arguments set forth above and specifically at pages 8-10 of the Amendment filed July 5, 2005 and pages 9-11 of the Amendment filed March 21, 2007. Applicant again points out that MPEP § 707.07(f) requires that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Contrary to the directive set forth in MPEP § 707.07(f), the Examiner again merely repeats verbatim the same grounds of rejection that Deluca teaches generating a compound message including a text part and at least one graphical icon part. (See pg. 2 of the Office Action dated January 4, 2006, pg. 2 of the Office Action dated September 21, 2007 & pg. 2 of the current Office Action dated May 24, 2007) In the *Response to Arguments* section, the Examiner merely refutes Applicant's assertion that the "[t]here is no motivation to combine Miller's teaching with the method of Deluca and Mochizuki" (See pg. 11 of the Office Action) and attempts to provide arguments for combining Deluca, Mochizuki and Miller. (See pg. 12 of the Office action) However, nowhere in the *Response to Arguments* section (or any other section) of the Office Action does the Examiner address the arguments above that the combination simply does not teach all of the

features of claim 15 even assuming *arguendo* that the references can be combined. In other words, even when combined the cited combination of references do not teach or suggest all of the features of claim 15. As such, the above-mentioned arguments remain rebutted, and claim 15 is patentable at least for those reasons submitted above and previously of record. To the extent that the Examiner persists in this rejection, Applicant requests the Examiner to specifically address the arguments presented above, as required by MPEP § 707.07(f).

Additionally, in the Amendments filed July 5, 2006 and March 21, 2007, Applicant pointed out that the Examiner correctly conceded that Deluca does not teach or suggest the requirement for adding a graphical part to the message, the graphical part including a record for each of the at least one graphical icon part in a graphical format, and adding position information in the message defining a position of the at least one graphical icon part in the text part, as required by claim 15. However, the Examiner continues to rely on Mochizuki to make up for the deficient teachings of Deluca. (See page 3 of the Office Action) Applicant respectfully disagrees.

As noted above and in the Amendments filed July 5, 2006 and March 21, 2007, Deluca does not teach or suggest at least generating a compound message including a text part and at least one graphical icon part. Mochizuki does not make up for the deficient teachings of Deluca. Similar to Deluca, Mochizuki discloses a call receiver capable of receiving a transmitted message that includes a "graphic image code." Mochizuki explains that the graphic image code is a numeric code corresponding to a predefined illustration residing in the receiving device. The graphic image code is a numeric code corresponding to a predefined illustration residing in the receiving device. To be precise, Mochizuki, (either alone or in combination with Deluca and Miller) at best, discloses a receiver, which includes a code memory storing graphic image units and graphic image unit codes. Mochizuki discusses that code information is extracted from a message. The code information includes a graphic image unit code and a character data code. "Based on the code information, a graphic image unit corresponding to the graphic image unit code and a piece of character data ... are read from the code memory" (i.e., graphic image code memory 108; See FIGS. 4A and 4B of Mochizuki) "and then the message with the graphic image unit and the piece of character data is displayed on [a] display." (See Abstract of Mochizuki; See Col. 2, lines 1-10 of Mochizuki) (emphasis added).

Additionally, in the Amendments filed July 5, 2006 and March 21, 2007, it was pointed out that FIGS. 4A and 4B of Mochizuki (either alone or in combination with Deluca and Miller) show the graphic image codes disclosed therein are <u>alphanumeric codes</u>. <u>Nowhere</u> in Mochizuki is there any mention, teaching or suggestion that the graphic image codes are graphic images or graphic image parts. For instance, column 6, lines 57-67 of Mochizuki describes that the control processor 104 asks the user whether to input a desired <u>graphic image code</u> in the transmission message. (See e.g., FIG. 6A in which the user inputs the alphanumeric graphic image code "02" in the transmission code) Such user's operation causes the control processor to store the selected graphic image <u>code</u> (GIC) (e.g., "01," "02," "03," "04," "05," "06," "07," and "08"; See FIGS. 4A and 4B) in the transmission message. Applicant again submits that in view of the foregoing disclosure, Mochizuki (either alone or in combination with Deluca and Miller) fails to teach or suggest that the transmission message disclosed therein generates a compound message *including* a text part *and at least one graphical icon part*, as required by claim 15. Therefore, Mochizuki (either alone or in combination with Deluca and Miller) also fails to teach and is incapable of suggesting "adding a graphical part *to the message*, the graphical part including a record for each of the at least one graphical icon part *in a graphical format*, and adding position information in the message defining a position of the at least one graphical icon part *in the text part*, as required by claim 15.

Applicant again submits that contrary to the directive set forth in MPEP § 707.07(f), the Examiner has not responded to the arguments set forth above and specifically at pages 10-11 of the Amendment filed July 5, 2006 and pages 11-12 of the Amendment filed March 21, 2007. Instead, the Examiner merely repeats verbatim the same grounds for rejecting claim 15 on the basis that the "Mochizuki teaches adding [a] graphical part to the message, the graphical part including a record of each of the at least one graphical icon parting in a graphical format." (See pg. 3 of the Office Action dated September 21, 2006, pg. 3 of the Office Action dated January 4, 2006 & pg. 3 of the current Office Action dated May 24, 2007). As noted above, the *Response to Arguments* section merely contains the sweeping assertion that there is motivation to combine Deluca, Mochizuki and Miller without providing any substantive explanation whatsoever to address Applicant's arguments above. Even when combined Deluca, Mochizuki and Miller simply does not teach or suggest all of the features of claim 15 for at least the foregoing reasons.

Accordingly, claim 15 is patentable at least for the reasons set forth above and those previously of record.

The Examiner again correctly concedes that "[b]oth Deluca and Mochizuki … fail to teach [that the] graphical icon part is in a graphical format." (See pg. 3 of the Office Action). However, the Examiner relies on Miller to make up for the deficiencies of Deluca and Mochizuki. Applicant respectfully disagrees and submits that the Examiner is giving the combination of Deluca, Mochizuki and Miller credit for more than they actually teach.

Miller, in contrast to claim 15, merely discloses a wireless multimedia communications method and apparatus that permits a subscriber of a personal communications device 411 to receive and generate multimedia messages from known wireless communications devices such as cellular telephones. According to Miller, a multimedia message may be received by a network and delivered to a subscriber of the wireless service. The subscriber is subsequently notified by the network of the message and then delivers the message and any multimedia attachments of the message to the device 411 of the subscriber. (Col. 1, lines 48-62) Alternatively, the device 411 may generate a multimedia message to be sent to another device 411 of a subscriber. Miller, at best, discloses that the multimedia attachments may consist of text, speech, fax, image, [and] video" data. (Col. 1, lines 34-36) More particularly, Miller describes that the multimedia messages disclosed therein may be a plain text file 404, a common graphics file 405 (e.g., "Power-Point") and sound file 406 in .wav format. (Col. 4, lines 29-35)

In rejecting claim 15, the Examiner continues to rely on column 1, lines 31-35 and 38-70 of Miller (in combination with Deluca and Mochizuki) as disclosing transmitting messages that includes a graphical image and that it would have been obvious at the time of the invention to include Miller's teachings with the methods of Deluca and Mochizuki in order to allow users to transfer image files. (See *id*.) Applicant again respectfully disagrees and submits that even assuming *arguendo* that Miller discloses transmitting messages which include graphical images, the combination still does not teach or suggest all of the features of claim 15. Applicant again points out that column 4, lines 26-35 of Miller describes that when a subscriber (e.g., Radhika) sends an e-mail with multimedia attachments to another subscriber (e.g., Thomas) the "attachments 404, 405 and 406 [are] in the upper panel" of an internet browser screen and are not within the text of the message "shown in the scrollable text window 403." (See FIG. 4(b) of Miller). Similarly,

as can be seen in FIGS. 4(h) and 4(i) of Miller, the text message received from a subscriber, such as Radhika, at device 411 is separate and distinct from the graphics file attachment 406 such as the Power-Point attachment. (Col. 5, lines 24-40) To be precise, FIG. 4(i) clearly shows that the graphics file attachment 405 (i.e., "4:PowerPoint (64K)") is not within the text message 404 shown in FIG 4(h) (i.e., "Hello Thomas, I am enclosing a copy of a recent luc"), as required by claim 15. In view of the foregoing disclosure, Miller (either alone or in combination with Deluca and Mochizuki) does not teach or suggest at least one graphical *icon part* that is in a *graphical* format *in the text part*, as required by claim 15.

Applicant points out that the Examiner does not clearly indicate in Miller exactly what is being relied upon as disclosing the claimed graphical icon part in a graphical image. (See pg. 3 of the Office Action) To the extent the Examiner is suggesting that the multimedia attachment corresponds to a graphical icon part, there still is no multimedia attachment in a graphical format *in the text part* of a message in the combination of Deluca, Mochizuki and Miller, as required by claim 15. In fact, neither Deluca, Mochizuki nor Miller, either alone or in combination, teaches or suggests "generating a compound message including a text part and at least one graphical icon part, ... *in a graphical format* ... in the *text part* ... and *transmitting* of the message ...," as claimed. There simply is no mention, teaching or suggestion in Deluca, Mochizuki and Miller, taken individually or in combination, relating to any "message including a text part and at least one graphical icon part ... in the text part," as claimed. Again, contrary to the directive set forth in MPEP § 707.07(f) the Examiner fails to provide any substantive explanation whatsoever to address the arguments set forth above and specifically at pages 12-14 of the Amendment filed March 21, 2007. Rather, the Examiner merely repeats verbatim the same grounds for rejecting claim 15 as in previous Office Actions (See pg. 3, of the Office Action dated September 21, 2006, pg. 3 of the Office Action dated January 5, 2006 and pg. 3 of the current Office Action dated May 24, 2007.

For at least the foregoing reasons, Applicant again submits that the combination of Deluca, Mochizuki and Miller are deficient and does not teach or suggest all of the features of claim 15. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 15 and its dependent claims 40, 46, and 52.

Since claims 29 and 39 contain features that are analogous to, though not necessarily coextensive with the features recited in claim 15, Applicant submits that claims 29 and 39 as well as their respective dependent claims 43, 49, 55 and 45, 51, 57 are patentable at least for reasons analogous to those submitted for claim 15.

II.   Rejection of Claims 52, 55 and 57 under 35 U.S.C. § 103(a)

Claims 52, 55 and 57 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Deluca et al. in view of Mochizuki further in view of Miller further in view of U.S. Patent No. 6,032,025 to Sugio et al. (hereinafter referred to as "Sugio"). Applicant respectfully disagrees for at least the following reasons.

As discussed above, Deluca, Mochizuki and Miller (either alone or in combination) are deficient vis-à-vis independent claims 15, 29 and 39. Sugio does not make up for the deficiencies of Deluca, Mochizuki and Miller (either alone or in combination). Accordingly, claims 52, 55 and 57 are patentable at least by virtue of their respective dependencies from independent claims 15, 29 and 39. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claims 52, 55 and 57.

III.   Rejection of Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 and 56 under 35 U.S.C. § 103(a)

Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54 and 56 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio in view of Mochizuki further in view of Miller.

Claim 16 requires "[a] communication terminal for handling messages comprising," *inter alia,* "a user interface through which the user operates the terminal, the user interface including a display message editor application allowing the user to *generate a compound message* including *a text part* and at least *one graphical icon part*; and wherein the controller generates the *compound message for being transmitted* via the transceiver including a text part in a predefined message text character format, *a graphical part* including a record for each of the at least one *graphical icon part* in a *graphical format*, and information in the message defining a position of the at least *one graphical icon part in the text part*."

Applicant again submits that the combination of Sugio, Mochizuki and Miller does not teach or suggest at least the above features of claim 16. In contrast, to claim 16 and as pointed out in the Amendments filed July 5, 2006 and March 21, 2007 Sugio, at best, discloses the display of a message, including a portrait image, on a receiving device (e.g., pager 4). Similar to Deluca and Mochizuki, the portrait image that is ultimately displayed on the receiving device of Sugio is not contained in the message that is transmitted to the receiving device. Rather, the transmitted message contains an alphanumeric "image designating code," (e.g., "portrait codes" "21" to "36" (See FIG. 4 of Sugio)) which is analogous to the numerical code of Deluca and Mochizuki. This image designating code of Sugio causes the pager 4 to retrieve from memory (e.g. portrait table stored in ROM 19) and display a portrait image corresponding to the transmitted and received image designating code. (See Abstract; Col. 2, lines 30-56 of Sugio; Col. 6, lines 27-34 of Sugio). Sugio, at best, discloses that the message may include "characters, numerals, and symbols." (See Col. 2, lines 32-33 of Sugio). For instance, a message may contain the numerals and symbols "*5*528," which causes a predefined portrait (i.e., portrait 28) to be displayed on the pager 4 (See Col. 9, lines 24-34; FIG. 8 of Sugio).

Additionally, in the Amendments filed July 5, 2006 and March 21, 2007, Applicant pointed out that FIGS. 36A-36E (among others) and the corresponding description, indicate that only the image designating code (illustrated in the transmission code display section 243 and containing only numerals and symbols, and not the actual image itself, is transmitted. (See Col. 24, lines 39-42; FIGS. 36A-36E of Sugio). Based on the foregoing, Applicant respectfully submitted that Sugio (either alone or in combination with Mochizuki and Miller) simply does not teach or suggest that the message disclosed therein includes a graphical icon part and as such, the combination of Sugio and Mochizuki fails to teach or suggest "a display message editor application allowing the user to generate a *compound* message *including a text part and at least one graphical icon part*," as required by claim 16. Given that Sugio does not teach or suggest a message containing a graphical icon part, but rather, at best, discloses that the message contains an image designating code, Sugio (either alone or in combination with Mochizuki and Miller) also fails to teach or suggest a "controller generates *the compound message* for being *transmitted* … including a text part … a graphical part including a record for each of the at least one graphical icon part in a graphical format," as required by claim 16. There simply is no message

in Sugio (either alone or in combination with Mochizuki and Miller) that includes a text part and a graphical icon part that is transmitted, as required by claim 16.

In the current Office Action, the Examiner has not responded to the arguments set forth above and on pages 11, 12, and 13 of the Amendment filed July 5, 2006 as well pages 15, 16, and 17 of the Amendment filed March 21, 2007. As noted above, MPEP § 707.07(f) requires that "[w]here the [A]pplicant traverses any rejection, the [E]xaminer should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In contrast to the requirements of MPEP § 707.07(f), the Examiner merely repeats verbatim the grounds of rejection in the Office Action dated January 4, 2006 and September 21, 2006 with respect to Sugio allegedly disclosing "a display message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part," as required by claim 16. In the *Response to Arguments* section of the Office Action, the Examiner merely asserts that "[t]here is ... motivation to combine Miller's teaching with the method of Sugio and Mochizuki." (See pgs. 11 & 12 of the Office Action) However, the Examiner has not addressed Applicant's argument above that even if combined Sugio, Mochizuki and Miller do not teach or suggest all of the features of claim 16, for at least the reasons noted above. Accordingly, those arguments remain rebutted, and claim 16 is patentable at least for the reasons noted above and those reasons previously of record.

In the current Office Action, the Examiner again correctly concedes that, Sugio fails to teach or suggest the requirement for "information in the message defining a position of the at least one graphical icon part in the text part," as recited by claim 16. (See pg. 6 of the Office Action) However, the Examiner again relies on Mochizuki to make up for the deficient teachings of Sugio. Applicant respectfully disagrees and submits that the Examiner is giving the references credit for more than they actually teach.

As pointed out above and in the Amendments filed July 5, 2006 and March 21, 2007, Sugio does not teach or suggest at least "a display message editor application allowing the user to generate a compound message *including a text part and at least one graphical icon part*; and the controller generates the compound message for being transmitted ... *including a text part ..., a graphical part* including a record for each of the at least one *graphical icon part in a graphical format*," as required by claim 16 and Mochizuki does not make up for the deficient teachings of Sugio.

In the Amendments filed July 5, 2006 and March 21, 2007, it was pointed out that similar to Sugio, Mochizuki discloses a call receiver capable of receiving a transmitted message that includes a "graphic image code." As noted above, the graphic image code of Mochizuki is a numeric code (e.g., "01," "02," "03," "04," "05," "06," "07," "08," and "09") corresponding to a predefined illustration residing in a graphic image code memory 108 of the call receiver. (See FIGS. 1, 4A & 4B of Mochizuki) Mochizuki, at best, discloses a receiver, which includes a code memory storing graphic image units and graphic image unit codes. Mochizuki discusses that code information is extracted from a message. The code information "includes a graphic image unit code and a character data code which are included in the message." "Based on the code information, a graphic image unit corresponding to the graphic image unit code and a piece of character data ... are read from the code memory" (i.e., graphic image code memory 108; See FIGS. 4A and 4B of Mochizuki) "and then the message with the graphic image unit and the piece of character data is displayed on [a] display. (Abstract of Mochizuki; Col. 2, lines 1-10 of Mochizuki) (emphasis added) In view of the foregoing, Mochizuki, at best, discloses that the graphic image codes disclosed therein are alphanumeric codes. Nowhere in Mochizuki (either alone or in combination with Sugio and Miller) is there any teaching or suggestion that the graphic image codes are graphic images or graphical icon parts or graphical parts. Rather, the graphic image unit codes are merely alphanumeric codes included in the message which correspond to images prestored in a memory (e.g., graphic image code memory 108). As such, it was submitted that Mochizuki fails to teach or suggest at least "the user interface including a display message editor application allowing the user to generate a *compound message* including a *text part* and at least one *graphical icon part* ... for being transmitted," as required by claim 16. In contrast to claim 16, it was submitted that Mochizuki (either alone or in combination with Sugio and Miller) discusses that the transmission message disclosed therein does not include the actual graphic image, but merely includes a corresponding graphic image code. The graphic image is subsequently extracted from a memory of a receiving device so that the graphic image can then be displayed. Therefore, Mochizuki (either alone or in combination with Sugio and Miller) also fails to teach and is incapable of suggesting "the controller generates the compound message *for being transmitted* ... including a text part ..., *a graphical part including* a record for each of the at least one *graphical icon part* in a *graphical format*, as required by claim 16. Given that the transmission message of Mochizuki does not include a graphical icon part,

Mochizuki, alone or in combination with Sugio and Miller, also fails to teach "information in the message defining a position of the at least one graphical icon part in the text part," as required by claim 16. There simply is no mention, teaching or suggestion relating to a graphical icon part in a text part of any message for being transmitted in Mochizuki (either alone or in combination with Sugio and Miller). Contrary to the directive set forth in MPEP § 707.07(f), the Examiner again has not responded to the arguments set forth above and specifically at pages 13-14 of the Amendment filed on July 5, 2006 and pages 17-18 of the Amendment filed March 21, 2007.

Rather, in asserting that the Mochizuki teaches "information in the message defining a position of the at least one graphical icon part in the text part" the Examiner merely repeats verbatim the grounds of rejection in the January 4, 2006 and the September 21, 2006 Office Actions. As such, the arguments remain rebutted, and claim 16 is patentable at least for the reasons above and those reasons previously of record.

In rejecting claim 16, the Examiner again correctly concedes that "Deluca and Mochizuki both fail to teach a graphical part including a record for each of the at least one graphical icon part in a graphical format" as required by claim 16. (See pg. 6 of the Office Action) Applicant points out that the Examiner did not cite to Deluca in rejecting claim 16 on page 5 of the Office Action, and as such the assertion that "[b]oth Deluca and Mochizuki both fail to teach a graphical …." is interpreted to read "[b]oth [Sugio] and Mochizuki both fail to teach a graphical …" However, the Examiner appears to rely on column 1, lines 31-70 of Miller to make up for the deficiencies of Sugio and Mochizuki and asserts that Miller "teaches transmitting messages that include [a] graphical format." (See *id.*) Applicant again submits that even assuming *arguendo* that Miller discloses transmitting messages that include a graphical image, the combination still does not teach or suggest all of the features of claim 16. As noted above with respect to independent claim 15, the cited portion of Miller merely describes that a subscriber is subsequently notified by the network of a message and then delivers the message and any multimedia attachments of the message to the device 411 of the subscriber. (Col. 1, lines 48-62 of Miller) Miller, at best, discloses that the multimedia attachments may consist of text, speech, fax, image, [and] video" data. (Col. 1, lines 34-36 of Miller) More particularly, Miller describes that the multimedia attachments disclosed therein may be a plain text file 404, a common graphics file 405 (e.g., "Power-Point") and sound file 406 in .wav format. (Col. 4, lines 29-35 of Miller)

As noted above, column 4, lines 26-35 of Miller describes that when a subscriber (e.g., Radhika) sends an e-mail with multimedia attachments to another subscriber (e.g., Thomas) the "attachments 404, 405 and 406 [are] in the upper panel" of an internet browser screen and are not within the text of the message "shown in the scrollable text window 403." (See FIG. 4(b) of Miller). Similarly, as can be seen in FIGS. 4(h) and 4(i) of Miller, the text message received from a subscriber, such as Radhika, at device 411 is separate and distinct from the graphics file attachment 406 such as the Power-Point attachment. (Col. 5, lines 24-40 of Miller) FIG. 4(i) clearly shows that the graphics file attachment 405 (i.e., "4:PowerPoint (64K)") is not within the text message 404 shown in FIG 4(h) (i.e., "Hello Thomas, I am enclosing a copy of a recent luc"). Given that the text message is separate and distinct from the graphics file attachment Miller, either alone or in combination with Sugio and Mochizuki, fails to teach or suggest "the controller generates the *compound message … including a text part* in a predefined message text character format, a graphical part including *a record for each* of the at least one *graphical icon part* in a *graphical format*," as required by claim 16. Nowhere in Miller, either alone or in combination with Sugio and Mochizuki, is there any teaching or suggestion pertaining to a compound message including a text part and a graphical icon part for being transmitted where the graphical icon part is in the text part, as required by claim 16. Additionally, nowhere in Miller, either alone or in combination with Sugio and Mochizuki, is there any teaching or suggestion relating to any graphics file attachment, forming part of a compound message, which includes a record for each graphical icon part in a graphical format, as required by claim 16. Contrary to the directive set forth in MPEP § 707.07(f), the Examiner has not responded to the arguments set forth above and specifically at pages 14 and 15 of the Amendment filed July 5, 2006 and pages 18-20 of the Amendment filed March 21, 2007.

Additionally, as pointed out in the Amendments filed July 5, 2006 and March 21, 2007, a graphical format, as would be understood by one skilled in the art, defines how graphic objects are created and stored. For example, many different graphical formats exist, but most formats are considered either a vector graphic format or a raster graphic format (See Appendix: *About File Formats*, Montana State University Publications and Graphics, August 2001, which was attached for the Examiner's convenience in the Amendment filed July 5, 2006). A vector graphic format defines graphic objects using coordinate geometry, while a raster graphic format defines graphic objects using pixels. (See id.) The Examiner's interpretation of a graphical

format is neither consistent with the specifications of Sugio, Mochizuki and Miller, nor consistent with the understanding of one skilled in the art. Both because the messages disclosed by Sugio, Mochizuki and Miller (either alone or in combination) do not contain a graphical part and because neither Sugio, Mochizuki and Miller (either alone or in combination) teach or suggest a graphical format, the recitation of claim 16 that the graphical icon part includes a record for each of the at least one graphical icon part in a graphical format is not taught or suggested by the combination of Sugio, Mochizuki and Miller. Applicant notes that in contrast to the directive set forth in MPEP § 707.07(f) the Examiner has not responded to the arguments set forth above and specifically at pages 14 and 15 of the Amendment filed July 5, 2006 and page 20 of the Amendment filed March 21, 2007.

Based on at least the forgoing, Applicant submits that the combination of Sugio, Mochizuki and Miller are deficient and does not teach or suggest all of the features of claim 16. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 16 and its dependent claims 17, 18, 19, 20, 21, 22, 23, 24, 26, 27, 28, 41, 47 and 53.

Since claims 25 and 30 contain features that are analogous to, though not necessarily coextensive with the features recited in claim 16, Applicant submits that claims 25 and 30 as well as their respective dependent claims 42, 48, 54 and 31, 32, 33, 34, 35, 36, 37, 38, 44, 50 and 56 are patentable at least for reasons analogous to those submitted for claim 16.

With further regard to claims 47, 48, 50, 53, 54 and 56, Applicant submits that these claims recited independently patentable subject matter given that the combination of Sugio, Mochizuki and Miller fails to teach or suggest wherein the at least one graphical icon part comprises at least one of an image or a picture as recited by claims 47, 48 and 50. And wherein the at least one graphical icon part comprises an animation sequence, as required by claims 53, 54 and 56. The Examiner relies on column 1, relies 31-35 of Miller as teaching a graphical icon part comprising an image or a picture. (See pg. 9 of the Office Action) Claims 47, 48 and 50 (in combination with other elements of the claims) require "a compound message including a text part and at least one graphical part … the at least *one graphical icon* part *in* the *text part*" "wherein the at least one graphical icon part comprises at least one of an image or a picture." As noted above, to the extent that Miller discloses a graphical part it is not included in the text part

within a compound message. As such, the combination of Sugio, Mochizuki and Miller does not teach or suggest the features of claims 47, 48 and 50.

The Examiner relies on column 42, lines 19-22 of Sugio as teaching a graphical icon part which comprises an animation sequence. (See pg. 9 of the Office Action) The cited portion of Sugio, at best, describes "a plurality of portraits [that] are switched from one another ... providing a dynamic picture portrait." Claims 54 and 56 (in combination with other elements of the claims) require "a compound message including a text part and at least one graphical part ... the at least *one graphical icon* part *in* the *text part*" "wherein the at least one graphical part comprises an animation sequence." Even assuming *arguendo* that the dynamic picture portrait of Sugio is an animation, the combination still does not teach or suggest all of the features of claims 54 and 56 given that Sugio either alone or in combination with Mochizuki and Miller fails to teach or suggest that the dynamic picture portrait is in a text part of a compound message, as required by claims 54 and 56. For at least these additional reasons, Applicant submits that claims 47, 48, 50, 53, 54 and 56 are patentable.

IV.   **Rejection of Claims 17, 18, 26, 27, 28, 31 and 32 under 35 U.S.C. § 103(a)**

Claims 17, 18, 26, 27, 28, 31 and 32 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sugio in view of Mochizuki further in view of Miller further in view of U.S. Patent No. 6,047,828 to Medina (hereinafter referred to as "Medina"). Applicant respectfully traverses this rejection for at least the following reasons.

As discussed above, Sugio, Mochizuki and Miller are deficient vis-à-vis independent claims 16, and 30. Medina does not make up for the deficiencies of Sugio, Mochizuki and Miller. Accordingly, claims 17, 18, 26, 27, 28, 31 and 32 are patentable at least by virtue of their respective dependencies from independent claims 16 and 30. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claims 17, 18, 26, 27, 28, 31 and 32.

V.   **Conclusion**

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Ke is encouraged to contact Applicant's

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undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,
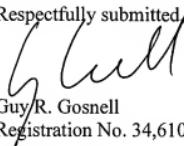
Guy R. Gosnell
Registration No. 34,610

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

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